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EXAMINER

SCHWARTZ, JORDAN MARC

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 08/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/621,223

Applicant(s)

AYOUB, ABBY

Examiner

Jordan M. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2003 and 21 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-12 and 14-17 is/are rejected.
- 7) ☒ Claim(s) 4 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5-10, 12, 14-15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Onoki et al patent number 4,076,863.

Onoki et al reads on these claims by disclosing the limitations therein including the following: an apparatus comprising a lens (abstract); a coating affixed to at least a portion of only the edge of the lens (column 2, lines 15-66); the coating as colored (column 2, line 21 re “black” and column 2, line 61); the coating effective to reduce the appearance of a white ring along the perimeter of the face of the lens (column 2, lines 15-66); the coating as opaque (column 2, line 21 re “black edge coating”); and placing the lens under a heat source (example 1). The lens of Onoki et al will inherently be within eyeglasses, this being reasonably based upon Onoki et al disclosing the lens as an ophthalmic lens within a frame and being prepared by an optician (abstract, column 1, line 44, column 2, line 49). The frame of Onoki will inherently either match or not match that of the coating, this being reasonably based upon the coating being disclosed as black and therefore the frame will either match or not match depending upon whether a black frame or some other colored frame is selected by the user. The coating of Onoki

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et al would inherently not be affixed to the face of lens element this being reasonably based upon Onoki et al specifically disclosing the coating affixed to the edge of the lens (column 2, lines 15-48). The method of Onoki et al would inherently remove any excess coating from the face of the lens, this being reasonably based upon Onoki et al disclosing that the coating would be applied to only the edge of the lens and not the optical portion (column 2, lines 15-48).

Claims 1, 3, 5-10, 12, 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Grendahl patent number 4,919,663.

Grendahl reads on these claims by disclosing the limitations therein including the following: an apparatus (abstract, column 2, line 49 re eyeglasses); comprising a lens (Figures 1 and 7, column 5, line 67 re lens element "32"); a coating affixed to at least a portion of only the edge of the lens (column 6, line 3); the coating as opaque (column 6, line 3); and that the lens can be used for eyeglasses (column 2, line 49). A highly pigmented or opaque coating applied to the peripheral edge of the lens of Grendahl will inherently reduce the appearance of a white ring along the perimeter of the face of this lens, this being reasonably based upon applicant not disclosing any specific qualities of the pigment used other than that is being applied to the edge of the lens and therefore based upon the similarity of the use of the pigment and its application to the edge of the lens similar to that of the claimed invention. The coating will inherently be colored, this being reasonably based upon Grendahl disclosing the coating as "highly pigmented" and "opaque" (column 6, line 3). Grendahl further discloses the coating as opaque (column 6, line 5). The coating of Grendahl would inherently not be affixed to the face of

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lens element "32" this being reasonably based upon Grendahl specifically disclosing the coating affixed to the edge of the lens (column 6, line 3). Grendahl further discloses placing the lens under a heat source (column 4, line 18); and allowing the coating to dry before placing the lens under the heat source (column 4, line 18 in that the lamination of the two lenses (during which heat is applied) would inherently take place after the formation and coating of the lens elements). The method of Grendahl would inherently remove any excess coating from the face of the lens, this being reasonably based upon Grendahl disclosing that the coating would be applied to only the edge of the lens and not the optical portion to apply anti-reflective properties (column 6, line 3). The frame of Grendahl will inherently either match or not match that of the coating depending upon the color of the frame selected by the user.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onoki et al or Grendahl et al.

Onoki et al and Grendahl disclose as is set forth above but do not specifically disclose the lens further comprising a scratch-resistant coating. However, Onoki et al discloses the lens comprising an impact resistance coating (column 2, lines 1-22) which will inherently impart scratch resistance. Regardless, the examiner takes Judicial Notice

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of the fact that it is well known in the art of ophthalmic lenses to impart ophthalmic lenses with scratch-resistant coatings for the purpose of providing additional protection to the lenses. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the lenses of either Onoki et al or Grendahl as imparted with a scratch-resistant coating since it is well known in the art of ophthalmic lenses to impart ophthalmic lenses with scratch-resistant coatings for the purpose of providing the lenses with additional protection.

Allowable Subject Matter

Claims 4 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: with respect to the allowable subject matter, none of the prior art either alone or in combination disclose or teach the claimed combination of limitations. Specifically, with reference to claim 4, none of the prior art either alone or in combination disclose or teach of claimed apparatus comprising an optical lens for use in eyeglasses, a colored coating affixed to a portion of only the edge of the lens, the coating effective to reduce the appearance of a white ring along the perimeter of the face of the lens, and specifically further with the colored coating as translucent. Specifically, with reference to claim 18, none of the prior art either alone or in combination disclose or teach of claimed method of applying a colored coating to an optical lens for use in eyeglasses comprising applying a colored coating to at least a portion of the edge of the lens such

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that the colored coating is affixed to only the edge of the lens, the coating effective to reduce the appearance of a white ring along the perimeter of the face of the lens, placing the lens under a heat source, and specifically further with the heat source as ultraviolet light.

Response to Arguments

Applicant's arguments filed March 3, 2003 have been considered but, with respect to the above rejected claims by Grendahl as set forth above, they are not persuasive. Applicant argues that Grendahl discloses an artificial hydrogel lens implant and not an eyeglass lens as claimed. However, Grendahl states that its "lens" can be used as an intraocular device but also in other applications which include eyeglasses (column 2, lines 48-51).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (703) 308-1286. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (703) 308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

A handwritten signature in black ink, appearing to read 'JMS', with a large, stylized loop at the end.

Jordan M. Schwartz
Primary Examiner
Art Unit 2873
July 30, 2003